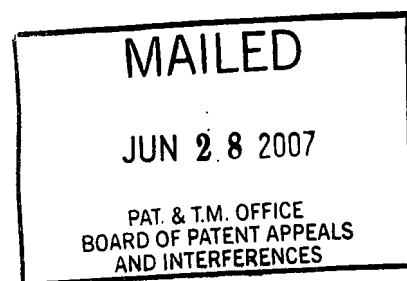


1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
9

10 Ex parte KI-OOK PARK, IN-EUNG KIM,
11 IN-SEOP JEONG, and TAE-SEOK PARK
12

13
14 Appeal 2007-2140
15 Application 09/892,790
16 Technology Center 2600
17

18
19 Oral Hearing Held: June 6, 2007
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21



22
23 Before FRED E. MCKELVEY, HOWARD B. BLANKENSHIP, and
24 ALLEN R. MACDONALD, Administrative Patent Judges.
25

26 ON BEHALF OF THE APPELLANT:
27

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33

34 The above-entitled matter came on for hearing on Wednesday, June 6,
35 2007, commencing at 2:27 p.m., at The U.S. Patent and Trademark Office,
36 600 Dulany Street, Alexandria, Virginia, before Victoria L. Wilson, Notary
37 Public.

1 MR. BUSHNELL: Are we short one judge?

2 JUDGE MacDONALD: No. Judge McKelvey is with us from
3 Hawaii.

4 Before you begin, once you are ready, let me know because there was
5 one item I needed to discuss with you so you are on the same page that the
6 office is on.

7 Are you ready?

8 MR. BUSHNELL: Okay. Robert E. Bushnell for Samsung
9 Electronics, Co., Ltd.

10 JUDGE MacDONALD: Fred, we are getting a lot of noise when you
11 move your papers. Is there any way to adjust the strength of the
12 microphone?

13 JUDGE McKELVEY: Volume.

14 JUDGE MacDONALD: Yes, the volume. Let's see if we can hear
15 you.

16 JUDGE McKELVEY: Okay. Can you hear me?

17 JUDGE MacDONALD: Yes, you are coming in loud and strong.

18 JUDGE McKELVEY: Okay. I'll try not to rattle these papers then. I
19 have got to make some notes, though.

20 JUDGE MacDONALD: We noticed going through the record that we
21 think it is not -- it was unintentional so we are just going to deal with it and
22 note it in the decision. The amendment that was filed June 18, 2002 -- let
23 me give you a list of claim numbers here so that you have those. Amended
24 dependent claims 22, 25, 32, 39, 43, 46 and 51. Okay.

25 And it looks like what happened is in the next amendment after those
26 had been changed, inadvertently. It was reverted back to the original file

1 claims, those numbers, and that carried through -- even though the office
2 views the correct claims -- there was clearly no intent to amend them to
3 return them to your original form.

4 It was not shown in any of the amendments to do that, it is just you
5 are showing a complete copy of the claims and that carried it over into the
6 appendix with the brief. So we are going to treat the claims in the appendix
7 as including the correct version rather than the inadvertent version for those
8 particular claims, which aren't on appeal but we wanted to still get that in the
9 record so that the examiner is aware of it.

10 MR. BUSHNELL: Very good.

11 Is the examiner in attendance here today.

12 JUDGE MacDONALD: No. No.

13 MR. BUSHNELL: Okay. Yes, I had understood he retired.

14 JUDGE MacDONALD: Yes, he has.

15 MR. BUSHNELL: Okay. All right. I will follow up on that
16 amendment and make sure we have got it.

17 JUDGE MacDONALD: Well, in our records, it reflects the correct
18 claims as the ones that were as intended. It is just that the later documents --
19 when you look through the record, the later amendments have the incorrect
20 version in their extraneous section and the same with the appendix in the
21 brief, which doesn't -- so the examiner is working from one set of claims and
22 the brief is working from a slightly different set, so -- fortunately, none of
23 those were the ones on appeal.

24 MR. BUSHNELL: Yes.

25 Okay. Turning to the claims on appeal --

26 JUDGE McKELVEY: Allen, I'm having a little trouble hearing here.

1 JUDGE MacDONALD: Okay.

2 Is the microphone turned on, Mr. Bushnell.

3 MR. BUSHNELL: Yes, it is green. Should I push this or --

4 JUDGE MacDONALD: No, maybe it is just being a little closer.

5 MR. BUSHNELL: How is this?

6 JUDGE McKELVEY: That's better. Thank you, sir.

7 MR. BUSHNELL: All right. Turning now to the claims 1 appeal,
8 which are, basically, independent claims 21, 31, what we have are
9 independent claims 42, 52 and 55 are now allowed and all rejections except
10 the rejection of 21 and 31 together with dependent claims 30, 32 and 41 have
11 been rejected under 35 USC Section 102(a) over Nepela 981.

12 Now, the board did remand the application to the examiner and
13 requested the examiner to annotate figure 5c of Nepela and the examiner did
14 that in various fashions. Since that time, we have had the Supreme Court
15 has given us some guidance in KSR versus Teleflex, and the following
16 week, the Court of Appeals for the Federal Circuit in Leapfrog Enterprises
17 versus Fisher-Price, I guess that's number 06-1402, is weighed in with its
18 interpretation.

19 Now, Leapfrog was essentially a question of obviousness, not
20 anticipation; however, as a prerequisite to that, there was a question of claim
21 interpretation of infringement and the court gave us some guidance under
22 what we could call the doctrine of claim language surplusage. So if you
23 look at -- that's on page 5 of Leapfrog. If you look at claims 21 and 31, they
24 include the language "including a side wall portion" in appellant's clause "at
25 least one of said, not more than two, separate air-bearing platforms including
26 a side wall portion."

1 JUDGE MacDONALD: One second. Just for the clerk, "side wall" is
2 two words in this situation.

3 MR. BUSHNELL: I gave her a copy of the notes.

4 JUDGE MacDONALD: Okay. Sorry.

5 MR. BUSHNELL: Now, Nepela 981 doesn't use the term "side wall
6 portion" in any respect. In fact, in the subclass that Nepela and applicant --
7 or appellant classified nobody uses that term. It is an art recognized term
8 and if you do a broader search of the PTO database, "side wall" is
9 prominently illustrated for various structural aspects, surfaces usually.

10 Now, Nepela 981 doesn't describe any feature in his more than 19
11 indiscrete embodiments of the various negative air pressure slider with the
12 term "slide wall portion." Consequently, if Nepela 981 doesn't anticipate
13 applicant's -- or appellant's claims 21 and 31, Nepela 981 does so without
14 any teaching or suggestion of the appellant's side wall portion.

15 A finding of anticipation of claims 21 and 31 by Nepela 981 under
16 102(a) would be a determination that applicant's claim language "requiring
17 at least one of said, not more than two, separate air-bearing platforms,
18 including a side wall portion," would be superfluous because no such
19 determination would be necessary to the finding of anticipation.

20 And the guidance for that is the Court of Appeals of the Federal
21 Circuit in its Leapfrog Enterprises, Inc., page 5.

22 JUDGE MacDONALD: Let me interpret for a second. I'm going
23 through the briefs. I think there were four of them. I didn't see any
24 discussion of exactly what appellant considered a side wall portion to be. I
25 saw references to the specification but could you tell us exactly what that
26 structure -- what you believe the claim is limited to with that structural

1 language?

2 MR. BUSHNELL: Okay. That structural language, "side wall
3 portion," I did cover in the supplement to the briefs when the examiner gave
4 us his handwritten annotation. The examiner in his annotation referred to
5 the center slogger or -- excuse me -- the center air-bearing 108 and he
6 referred to the boundary of that.

7 Now, there is no illustration of that. I suppose for purposes of
8 argument, we can presume it has some thickness.

9 Now, the appellant -- and I mentioned this in the supplement to the
10 brief -- in column 6 at line 37, as shown in figure 6, the cross rail 130 may
11 be smoothly configured without inner or outer corners, or instead may be
12 formed by a series of connected straight side wall segments, or a
13 combination thereof.

14 JUDGE MacDONALD: And that's the structure shown in figure 6?

15 MR. BUSHNELL: Yes. And if you look at those, there is two side
16 wall portions and they are arcing inwardly.

17 In contradistinction to that, we have Nepela, which expressly teaches -
18 - he has to have certain recesses -- okay. Nepela, referring to figures 5a
19 through 5d, but actually all 19 embodiments, expressly teaches that relief
20 sections 126 were along his side, are provided for ease of manufacturing.

21 That's Nepela column 5 line 55. These relief sections may not be
22 arbitrarily disregarded to make a determination of anticipation.

23 JUDGE MacDONALD: Fred, we are getting too much noise. Sorry.

24 JUDGE McKELVEY: Okay. I'm sorry.

25 MR. BUSHNELL: I'm not going to go beyond this.

26 JUDGE MacDONALD: Yes. My concern there, though, is you're

1 focusing on those channels, and, in fact, your figure 6 has channels also
2 around the side wall segments so I'm a little confused how that distinguishes
3 -- how your use of the term distinguishes from the prior art structure.

4 In fact, going through your specification, you have talked about in
5 either as a single word "sidewall" or two words "side wall" in either
6 segments or portion, all, every structure that forms the U-shaped structure in
7 figure 6, both of the larger sections near the back or near the bottom of the
8 figure are labeled at certain points as side wall portions and then the area
9 you are pointing to in column 6 specifically says that the cross rail is itself
10 formed of side wall segments, which are not near the sides of the device,
11 they are in the center.

12 MR. BUSHNELL: If I could object. The cross rail itself is the
13 traverse structure that connects the side rails. That's in dependent claims. It
14 is not in the independent claims. We separately defined cross rails, for
15 example, in claim 22.

16 JUDGE MacDONALD: Actually, that's the problem because the
17 claim 22 that's in play actually doesn't have cross rail.

18 MR. BUSHNELL: That's correct. So what you see in the center is
19 not the cross rail -- excuse me -- is the cross rail. That's a feature of
20 dependent claims. Side walls --

21 JUDGE MacDONALD: What I am saying is the cross rail is not in
22 this claim string at all.

23 MR. BUSHNELL: That's correct. If you turn to the dependent claims
24 --

25 JUDGE MacDONALD: 22.

26 MR. BUSHNELL: Yes.

1 -- then there is a cross rail portion.

2 JUDGE MacDONALD: No. Actually, claim 22 says, "a negative
3 pressure bearing slider according to claim 21 further comprising a gap
4 disposed within the U-shaped, air-bearing platform." That's the amended
5 version of 22. What's in the brief does have a cross rail but that was the
6 canceled version of 22.

7 MR. BUSHNELL: Very good. That's correct.

8 We have a gap, as opposed to the air vent, which Nepela teaches are
9 machined to the same depth.

10 JUDGE MacDONALD: Right. And the examiner did not contend
11 that 22 was anticipated. He only contended that the U shape in the center
12 there fits the claim language of 21 and that those segments, the legs that
13 come back, are side walls -- at least that was what I understood from the
14 rejection -- and by the definitions in your specification, it looks like the side
15 wall, every single piece, in figure 6, that forms the U has been defined as a
16 side wall somewhere in the specification.

17 So I would think an artisan looking at that would understand that "side
18 wall" is just a term that refers to one of these straight structures.

19 MR. BUSHNELL: Well, first of all, Nepela doesn't show any
20 elevational view except in figure 2 so we don't know that. But presuming
21 for purposes of argument that it does have some thickness, side wall, as
22 illustrated in figure 6, is contiguous. Remember, we are defining a unitary
23 structure here. This is not a combination of old elements.

24 I was here, what, three weeks ago and I showed you a bottle cap with
25 a lid and -- it is a unitary structure. It is born as one piece. It is not a
26 combination. KSR doesn't address this. Graham versus John Deere doesn't

1 address this, and neither does Cook Chemical. Although, in that bottle cap,
2 there was good language by the court in Cook Chemical.

3 But here we have got a one-piece structure. It is born as one piece,
4 not a combination of old elements. Second, these are minute pieces. And,
5 third, if you read Nepela carefully and look at his figures 7 and 8, there is a
6 reason for each of these geometric contours and he has proven that he gets a
7 certain result.

8 Now, this is not a nose of wax that we can arbitrarily move these
9 around. What applicant has as a side wall shown in figure 6a is a structure
10 that provides an air-bearing surface that has its side wall contiguous with the
11 slider. Remember, it is one-piece slider. If we don't attribute some meaning
12 to "side wall," we have got anticipation without reading all the language of
13 the claim.

14 JUDGE MacDONALD: Which specific language of the claim?

15 MR. BUSHNELL: Okay. There is three elements.

16 JUDGE MacDONALD: I heard you say terms that I don't see in the
17 claim.

18 MR. BUSHNELL: Well, we have got "side wall" in the claim. We
19 can't ignore that presence there, particularly when Nepela doesn't have the
20 structure of 6a and doesn't have any air-bearing surface contiguous with the
21 vertical sides of the slider. Second, separate. Okay?

22 JUDGE MacDONALD: Stop you there. Where is the air-bearing
23 surface that's contiguous that is in the definition of the U-shaped platform?

24 MR. BUSHNELL: Okay. In figure 6a, 6b, it is not numbered. They
25 didn't put --

26 JUDGE MacDONALD: No. No. I mean in claim 21. I'm willing to

1 agree with you that any claim language there has to be given weight but I'm
2 hearing you argue things that I can't find in the claim.

3 MR. BUSHNELL: Okay. You asked for a definition of how the
4 specification defines the term "side wall." That's what I am saying. Side
5 wall is the portion of the slider that forms the air-bearing surface that is
6 formed from contiguous wall of the insert. That's a feature that's completely
7 absent for specific reasons from Nepela, and, actually, from every other
8 reference we could find.

9 Nepela insists that he has these recesses and he says why he has them.
10 It is not an accident that they are in all 19 embodiments in Nepela.

11 JUDGE MacDONALD: Okay.

12 MR. BUSHNELL: That's what we expressly show in figure 6.

13 JUDGE MacDONALD: And I'm looking at the two figures side-by-
14 side and I see the same channels in your figure 6 that reference teaches, so --

15 MR. BUSHNELL: You are talking about channels 100 between the --
16 okay. What we have claimed here, basically, is that U-shaped structure. We
17 are not claiming the upper air-bearing surface on either the left or the right.
18 What the examiner has done, however, is taken the third air-bearing surface,
19 which Nepela says is his additional air-bearing surface, namely, his center
20 pad 108, and divided it up.

21 Now, there is a book up in Walter's Art Gallery in Baltimore this week
22 and they found it is a Palmquist of Aristotle's writing. Aristotle makes the
23 point in that text that four feet on a bed does not put the bed in the same
24 category as an animal with four feet. The fact that this is a U-shaped
25 structure doesn't make it applicant's separate -- wait a minute -- two separate
26 air-bearing platforms. 108 is one integral continuous air-bearing platforms.

1 If we are going to interpret Nepela to have 108, the center pad,
2 anticipate, we are not operating Nepela in its intended mode because we
3 have gotten rid of his channels that he says are essential for his stability.

4 JUDGE MacDONALD: Yes, but I think you are taking items 112 and
5 114 and attempting to put them into the rejection the examiner has done and
6 the examiner did not use those as far as I can tell.

7 MR. BUSHNELL: Yes, that's his mistake.

8 JUDGE MacDONALD: Well, I would --

9 MR. BUSHNELL: You can't ignore them.

10 JUDGE MacDONALD: But --

11 MR. BUSHNELL: What the examiner has done, and you run into this
12 more in criminal defense, is rewrite the express teachings of Nepela and I
13 have outlined that in my brief. If you annotate what the examiner wrote, "U-
14 shaped, air-bearing platform 108, defining a negative pressure cavity," and
15 the examiner's insert, "(cavity which includes a space between the rail of the
16 U-shaped, air-bearing platform which, indeed, provides a central recess
17 cavity that extends from the central pad 108 to the trailing of the slider.)"

18 The examiner says that's column 2, lines 50, 51. Actually, the
19 examiner is not talking about any U-shaped, air-bearing platform, he is
20 talking about the central recess cavity and he is talking about those groups or
21 his vents, as he calls them. I outlined that on pages 4 and 5.

22 Now, why did the examiner rewrite Nepela? We can't dissect Nepela.
23 It is one integral structure. It is not a combination of old parts. There is no
24 routine era out there resembling old parts. We start and we finish with one
25 complete integral product.

26 Now, if we are going to take a chisel to Nepela and rearrange the

1 surface, we are going to end up with a different letter, just as the old printers
2 did when they took a chisel to a wood block. And that's not the letter the
3 applicant designed.

4 Now, the last point I would like to make, we cannot ignore applicant's
5 limitation "not more than" in the clause. The fact that applicant, unlike
6 Nepela, found a structure that was able to work with not more than two air-
7 bearing platforms is not surplus language under the court's interpretation in
8 Leapfrog. Nepela doesn't teach he can work with center pad 108. He
9 doesn't suggest anything of this like.

10 Now, if we are going to chisel -- again, take a chisel to Nepela, we are
11 ending up with a different character and it is going to print a different
12 impression on the paper.

13 JUDGE MacDONALD: There is some language in there, a claim that
14 limits it to just the U shape?

15 MR. BUSHNELL: For the -- just a U shape?

16 JUDGE MacDONALD: Well, you are indicating there can't be
17 anything else in the structure.

18 MR. BUSHNELL: We are talking about the air -- okay -- U-shaped,
19 air-bearing platform, okay. Nepela teaches those but he has got three plus,
20 specifically three, his side rails plus his center pad. That's crucial. And he
21 teaches it is crucial and he makes measurements in figures 7 and 8 in those
22 Cartesian graphs showing why they are crucial.

23 Appellant has U-shaped, air-bearing platform defining his negative
24 pressure cavity. You can argue about what Nepela teaches defines his but it
25 is generally the tail end of those vents, not the little insert in his concave or
26 U-shaped center pad. That's what he says. Remember, these are minuscule.

1 So when you put it under an electron microscope, who knows what the
2 center pad actually looks like.

3 You know what you wanted it to look like but, in reality, what did you
4 actually get. "Comprising not more than two separate air-bearing
5 platforms," we cannot ignore that language.

6 JUDGE MacDONALD: Let me, at least so I can understand --

7 MR. BUSHNELL: Sure.

8 JUDGE MacDONALD: -- attempt to rephrase what I think you are
9 saying so I can make sure that's what I -- that Nepela -- that Nepela, the
10 reference, shows a structure but you are contending it is not clear from
11 what's in the reference that either this structure the examiner is pointing to
12 forms a negative pressure cavity or is an air-bearing platform.

13 MR. BUSHNELL: No. I think -- no. He expressly says he has an
14 air-bearing platform. There is a plethora air-bearing platform art. He also
15 teaches a negative pressure cavity -- no question. The question is how does
16 Nepela define that. And the examiner is trying to argue that it is wholly
17 within that concave portion of center pad 108.

18 That's not what Nepela says. Recognizing, again, these things are
19 minuscule. Yes. And the fact that they are minuscule is significant. They
20 have to be because what they are doing -- there is completely different line
21 of patents on it. You are trying to keep this on the center line as it rotates --
22 as the disk rotates and there is completely different line of cases how you
23 detect when you started to go off the center line and the center line is smaller
24 than a hair so these things are really small.

25 What I am saying is, in view of their smallness, our drawings -- and
26 recognizing that the board very seldom takes dimensions off the drawing,

1 although on exceptional cases, these drawings are probably on the order of
2 100 plus greater than the actual product.

3 What Nepela is trying to do is make the point that he could have a
4 concave structure there and he is trying to nail it down as inventors do with
5 all possibilities, recognizing inventors, in my experience, are very picky
6 about what they disclose and want it faithful to their principles and they are
7 very picky about what they are claiming and how they describe it.

8 Nepela's description is very faithful to what I am telling you.

9 The examiner's -- he just doesn't feel comfortable with allowing 21
10 and 31. That's not a new experience for the board. Remember Yancy
11 Williams and the bar of religious soap and I came up here one time with a
12 soap bar hanger and we had nine references that showed the prior art and at
13 the point of departure from the prior art, the inventor had novelty.

14 It is the same thing here. The inventor knew that there is a difference
15 between the structure they were able to make fly, the stability they were able
16 to get and the accuracy reading the rotating disk with what they have defined
17 a U-shaped, air-bearing platform defining its negative pressure cavity --
18 negative pressure cavities are not new -- on the principal surface and the U-
19 shaped, air-bearing platform comprising not more than two separate air-
20 bearing platforms.

21 So there may be a gap, there may be no gap, and in the spec they
22 explain why the gap or no gap. There is advantages associated with
23 different -- and you recognize that, as Nepela makes clear, you use different
24 configurations for different disk designs. He has different reasons for
25 different aspects of his embodiments but there is no side wall.

26 I'm not sure how that contributes to ease of manufacturing but he said

1 it does and that's one of these objects.

2 JUDGE MacDONALD: You just said it has no side wall. What are
3 you referring to as the side wall?

4 MR. BUSHNELL: Well, in applicant's, we have got our air-bearing
5 surface and we -- this is the side wall portion along here. It is contiguous
6 with the rest of the surface that would be here of the slider.

7 JUDGE MacDONALD: So in that situation, you are talking about the
8 wall that is along the side of the principal surface.

9 MR. BUSHNELL: That's correct.

10 JUDGE MacDONALD: Now, the specification limits the term "side
11 wall" to that situation in all cases?

12 MR. BUSHNELL: Well, the specification uses a side wall in one
13 instance and they refer to that structure, yes. But in all of the embodiments
14 claimed, that's true, just as it is also true in Nepela 981, that he has got a
15 recess between that side wall and the air-bearing surface and he attributes a
16 specific benefit to that recess.

17 JUDGE MacDONALD: Okay.

18 MR. BUSHNELL: Thank you, gentlemen.

19 Any questions, Mr. McKelvey.

20 JUDGE McKELVEY: No, no questions. Thank you very much.

21
22 (Whereupon, the proceedings at 2:56 p.m. were concluded.)
23
24